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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,383	08/20/2004	Peter J Dronzek JR.	181-039	7142

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EXAMINER

AHMAD, NASSER

ART UNIT PAPER NUMBER

1772

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/505,383

**Applicant(s)**

DRONZEK ET AL.

**Examiner**

Nasser Ahmad

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-97 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-97 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/20/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 7-15, 18-26, 29-37, 40-48, 51-59, 62-70, 73-81, 83-88 and 97 are rejected under 35 U.S.C. 102(b) as being anticipated by Egan (4544590).

Egan relates to an article of manufacture (figure-6) comprising a first support layer of film (1+2) with a permanent bond interface with adhesive (19), a second thin film (13) is adhesively secured to the lower surface of the first film at the permanent adhesive bond but having a separable interface between the adhesive and the release coat of film (13), and a third substrate (33) is laminated to the upper surface of the first layer with adhesive (37). As shown in figure-9, the article is a die-cut segment (47) wherein in the die-cut extends through all the layers except for film (13). The removable die-cut segment is provided with a selective variable adhesion through variable surface treatment (figure-21, wherein the release coat is provided in a discontinuous pattern) of the upper surface of film (13) such that the adhesion at the separable interface (between the release liner and the adhesive) is always less than the adhesion at the permanent interface between the adhesive and the film (1+2).

The treated area extends under the removable area defined by the die-cut.

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The film layer is polyester and is about 0.5 mils thick (col. 6, lines 1-10) which reads on claim 3.

The substrate layer can be of paper stock of 40-, 50-, or 60-pound weight (col. 6, lines 50-55) as per claim 4.

For claims 7-10, figure-21 shows that the area treated can be at least 10% but less than 90% and is of a geometric pattern such a polygon.

The intended use phrases such as "for providing", etc. and "optional" phrases have not been given any patentable weight because said phrases are found to be of positive limitations.

Claim 11 is directed to a surface treatment condition in the process of making the product and has not been given any patentable weight because said process condition is not germane to the issue of patentability of the product itself.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5-6, 16-17, 27-28, 39-40, 49-50, 60-61, 71-72 and 82-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egan in view of Kobe (6780484).

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Egan, as discussed above, fails to teach that the surface of the release liner film (13) is treated by flame treatment. Kobe discloses a release liner that has been flame treated to a dyne level of greater than 50 (col.18, 24-27) prior to silicone release coating. The treatment provides for stronger adhesion between the release coating and the liner. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Kobe's teaching of using a flame treated release liner surface in the invention of Egan with the motivation to provide for enhanced adhesion of the coating to the liner.

5. Claims 89-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egan in view of Grabau (7045186).

Egan, as discussed above, fails to teach a radio frequency transmitter in at least one of the article elements. Grabau discloses a label with a radio frequency transmitter in at least one of the elements of the label (abstract). Therefore, it would have been obvious to one having ordinary skill in the art to utilize Grabau's teaching of using radio frequency transmitter in a label in the invention of Egan with the motivation to provide for security y concern

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 1-44 and 89-92 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 12, 34, in section (ii), the "first thin film" and in section (iii), the phrase "the first thin film" are found to be indefinite for lack of antecedent basis.

Claim 23, section (vi), the phrase "said first thin film layer" is found to be indefinite for lack of antecedent basis.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-97 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-53 of copending Application No. 10/505392. Although the conflicting claims are not identical,

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they are not patentably distinct from each other because both the applications are directed to an article comprising a first, second and third thin film layers laminated together and having a card define therein by die-cut and variable surface treatment for variable adhesion.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Nasser Ahmad 6/26/06  
Primary Examiner  
Art Unit 1772

N. Ahmad.  
June 26, 2006.